

REMARKS

Reconsideration of the objections and rejections set forth in the Office Action dated October 6, 2005, is respectfully requested. In the Office Action, the Examiner rejected claim 29. Applicants have canceled claim 29 without prejudice and have added new claims 30-34. Accordingly, claims 30-34 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. Formalities.

In the Office Action, the Examiner objected to claim 29, noting a typographical error in the claim. Applicants appreciate the Examiner's careful examination of the present application and have incorporated appropriate correction into the new claims.

B. The Prior Art Does Not Disclose or Suggest an Information Transmitting Apparatus that Selects a Suitable Communication Protocol for Retransmitting Selected Blocks of Data to a Requesting Information Receiving Apparatus as Set Forth in the Pending Claims.

In the Office Action, the Examiner rejected claim 29 under 35 U.S.C. § 103(a) as allegedly being obvious by Applicants' admitted prior art in view of Harrington et al., United States Patent No. 6,289,012. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claim 30, neither the admitted prior art nor Harrington et al. anticipates or renders obvious new claim 30. Accordingly, claim 30, as well as new claims 31-34 that depend from claim 30, are in condition for allowance.

In contrast to the apparatus recited in new claims 30-34, none of the prior art references, either individually or in combination, disclose or suggest an apparatus that includes an information transmitting apparatus that is "arranged and constructed to, in response to the retransmission request, select a suitable communication protocol and

retransmit via the network the selected blocks of data to the first information receiving apparatus in accordance with the suitable communication protocol." As recognized by the Examiner in a prior Office Action, dated March 18, 2005, the Admitted Prior Art by Applicants fails to disclose an information receiving apparatus that is arranged and constructed to transmit a retransmission request to retransmit one or more selected blocks of data and an information transmitting apparatus that is arranged and constructed to, in response to the retransmission request, retransmit via the network the selected blocks of data to the first information receiving apparatus.

The Examiner relies on the teachings of Harrington et al. to supplement the Admitted Prior Art by Applicants and to allegedly provide a disclosure of the recited claim elements. According to the Examiner, Harrington et al. at Figs. 12, 15, 16; col. 11, lines 26-39, 45-52 disclose a client sending a request to retransmit data to a server during a reliability process and the server retransmitting blocks of data upon receiving a reliability packet from the client. Without acquiescing to the position of the Examiner, Applicants assert that the information transmitting apparatus of claim 30 further is "arranged and constructed to, in response to the retransmission request, select a suitable communication protocol and retransmit via the network the selected blocks of data to the first information receiving apparatus in accordance with the suitable communication protocol."

Harrington et al. do not teach or suggest that the server either determines a suitable communication protocol for retransmitting the blocks of data to the client or retransmits the blocks of data to the client in accordance with the suitable communication protocol. Instead, Harrington et al. mention the use of a single communication protocol, such as a multicasting protocol for use with multicast-enabled networks. (See Harrington et al. at Fig. 3; col. 2, lines 40-62; col. 7, lines 40-48.) Harrington et al. therefore do not disclose the selection of a suitable communication

protocol for retransmitting the blocks of data based, for example, on the bandwidth utilization status of the network and/or the number of blocks comprising the selected blocks of data.

At least one recited element of new claim 30 therefore is totally missing from Applicants' admitted prior art in view of Harrington et al. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, since the cited prior art references fail to disclose each and every element of independent claim 30, claim 30 is not anticipated. Applicants therefore submit that new claims 30-34 are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of Prior Art in a Manner that Precludes the Patentability of the Pending Claims 30-34 Under 35 U.S.C. § 103(a).

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met." (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references.

Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), *citing*, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

As discussed above, at least one recited element of new claim 30 is totally missing from the cited prior art references. Harrington et al., in fact, teach away from the use of certain communication protocols such as multicasting protocols as recited in new claim 34. For example, Harrington et al. state that "[c]oncurrent downloading of the same item to multiple users can occur when demanded by the user, not at some prescheduled time as with network multicasting. Also, unlike network multicasting, one user's problems do not impact download times for other users." (See Harrington et al. at col. 7, lines 44-48.) According to Harrington et al., the use of network multicasting presents further disadvantages because the network must be multicast-enabled and because multicasts must be scheduled, which is neither practical nor desirable in many applications. (See *id.* at col. 2, lines 51-62.)


The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claim are not found in the cited references. According, it is submitted that the cited prior art does not anticipate or render obvious new independent claim 30. Applicants therefore submit that claims 30-34 are in condition for allowance.

For at least the reasons set forth above, it is submitted that new claims 30-34 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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